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Sheridan Neimark
BROWDY AND NEIMARK, P.L.L.C.
624 NINTH STREET, NW
SUITE 300
WASHINGTON DC 20001-5303

In re Application of :
Andersch et al. :
Serial No.: 10/555,105 :DECISION ON PETITION
IA Filing Date: 20 April 2004 :
Attorney Docket No.: ANDRESCH=1 :

This letter is in response to the Petition under 37 C.F.R. 1.144 filed on 30 September 2009.

BACKGROUND

This application was filed as a national stage application in compliance with 35 USC 371 and as such is subject to PCT unity of invention rules.

On 16 June 2008, claims 1-6, 8-11 were pending and all were rejected in a non-final Office action. The examiner had not required an election of an invention or a species.

On 16 September 2008, applicants filed an amendment which added new claim 12.

On 19 February 2009, claims 1-6, 8-12 were pending. Claims 1-6 and 8-11 were rejected in a final Office action. New claim 12 was not addressed.

On 21 August 2009, claims 1-6, 8-12 were pending. Claims 1-6 and 8-11 were rejected in a supplemental final Office action. New claim 12 was withdrawn from consideration as being independent or distinct from the invention as originally claimed. The examiner stated that the core structures of claim 12 are distinct from the other species of the independent claims.

On 30 September 2009, applicants filed this petition under consideration.

DISCUSSION

The petition and file history have been carefully considered, with respect to the claims as currently pending.

Before turning to the merits of the petition, a few irregularities are noted in the prosecution history.

This national stage filing is entitled to PCT Unity of Invention practice with regard to any restriction or election of species requirement.

In withdrawing claim 12 from examination, the examiner failed to follow the criteria of PCT Rule 13.2 to evaluate Claim 12 in terms of same or corresponding technical features. Instead, the examiner turned to US restriction practice to conclude that the dependent claims were directed to an independent and distinct invention. This is not proper.

In withdrawing Claim 12 from examination, the examiner appears to be taking the position that the technical feature of the composition of independent Claim 1 is either a compound from Group 1 or a compound from Group 2, as described by dependent claim 12. This is incorrect. The composition of Claim 1 requires both a compound from Group 1 and a compound from Group 2. A requirement to elect either a Group 1 compound or a Group 2 compound would be inconsistent with International Search and Preliminary Examination Guidelines because both features are requirement by the composition of independent Claim 1. ISPE Guidelines Paragraph 10.07 states:

If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention. For example, suppose claim 1 claims a turbine rotor blade shaped in a specified manner, while claim 2 is for a "turbine rotor blade as claimed in claim 1" and produced from alloy Z. Then no objection under Rule 13 arises either because alloy Z was new and its composition was not obvious and thus the alloy itself already contains the essential features of an independent possibly later patentable invention, or because, although alloy Z was not new, its application in respect of turbine rotor blades was not obvious, and thus represents an independent invention in conjunction with turbine rotor blades.

As set forth in ISPE Guidelines Paragraph 10.17:

"The structural element may be a single component or a combination of individual components linked together."

Even if claim 12 had been directed to one of the compounds recited in composition claim 1, (which it was not), unity of invention would have been present in view of ISPE Guideline Example 15.

Claim 1: Compound A.

Claim 2: An insecticide composition comprising compound A and a carrier.

Unity exists between claims 1 and 2. The special technical feature common to all the claims is compound A.

Moreover, even if this application had been filed under 35 USC 111(a) (which it was not), dependent claim 12 would not be considered independent and distinct from independent claim 1 because Claim 12 requires all the limitations of Claim 1.

In view of these inconsistencies, the treatment of Claim 12 in the first and second FINAL Office actions on the merits has created confusion such that the Office has not established a clear record as required by MPEP 814, which states:

The examiner must provide a clear and detailed record of the restriction requirement to provide a clear demarcation between restricted inventions so that it can be determined whether inventions claimed in a continuing application are consonant with the restriction requirement and therefore subject to the prohibition against double patenting rejections under 35 U.S.C. 121. *Geneva Pharms. Inc. v. GlaxoSmithKline PLC*, 349 F.3d 1373, 1381, 68 USPQ2d 1865, 1871 (Fed. Cir. 2003). See also MPEP § 804.01.

Turning now to the merits of the petition, applicants are correct that Claim 12 has unity of invention with the already examined claims 1-6 and 8-11 for the following reasons:

Independent Claim 1 is directed to a composition that requires a pesticide from Group I and a pesticide from Group 2. Dependent claims 4 and 5 further describe the pesticide from Group I. Claim 12 depends from claim 5 and sets forth a subset of compounds from Group 2. Each of the compounds listed in withdrawn claim 12 are also listed in already-examined claim 1.

12. (New) The composition of claim 5 wherein the active compound of group 2 is selected from the group consisting of clothianidin, imidacloprid, tefluthrin, tebupirimfos, spinosad, and fipronil.

Claim 12 meets the requirements of 37 CFR 1.75(c) because it requires all the limitations of the independent and intervening claims and because claim 12 further limits the independent and intervening claims.

Finally, applicants are correct that the examiner cannot elect a species for applicants. Had a lack of unity requirement been originally made amongst the species of Claim 1, (which it had not) the examiner could not have been permitted to make an election for applicants, per MPEP 818.03.

Applicant must make his or her own election; the examiner will not make the election for the applicant. 37 CFR 1.142, 37 CFR 1.143.

DECISION

The petition is **GRANTED** for the reasons set forth above.

The election of species requirement mailed 21 August 2009 has been withdrawn.

The Office action mailed 21 August 2009 has been vacated as incomplete.

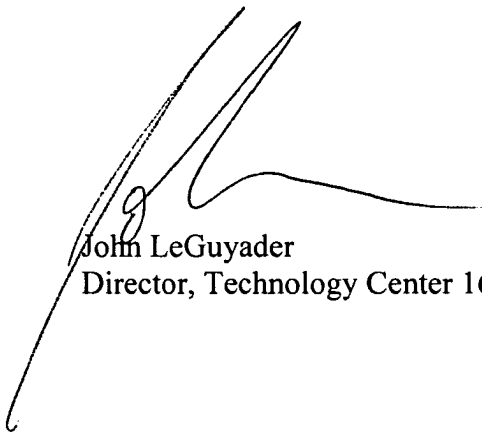
Claims 1-6 and 8-¹²~~11~~ will be examined together.

The application will be forwarded to the examiner for consideration of the papers for preparation of an Office action consistent with this decision.

Because the extensive delays in initiating prosecution on the merits in this application (mailing of two Final actions, both of which have been withdrawn and the delay in examining a claim which was presented over a year ago), the next Office action will be reviewed by the Supervisory Patent Examiner prior to mailing, per MPEP 707.02 second paragraph.

“The supervisory patent examiners are expected to personally check on the pendency of every application which is up for the third or subsequent Office action with a view to finally concluding its prosecution.”

Should there be any questions about this decision, please contact Quality Assurance Specialist Julie Burke, by letter addressed to Director, Technology Center 1600, at the address listed above, or by telephone at 571-272-0512 or by facsimile sent to the general Office facsimile number, 571-273-8300.



John LeGuyader
Director, Technology Center 1600